LIBRARY

Office - Supreme Court, U.S.
FILED
SEP 25 1957
JOHN T. FEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1957.

No. 407

RALPH F. STALLMAN,

Petitioner,

vs.

CASEY BEARING COMPANY, INC.,
A CORPORATION,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

FOORMAN L. MUELLER,
105 West Adams Street,
Chicago 3, Illinois,
JAMES M. NAYLOR,
420 Russ Building,
San Francisco 4, California,
Attorneys for Respondents.

September 23, 1957.

INDEX.

	PAGE
Additional Statement of Matter Involved	1
Restatement of Question Presented for Review	4
Argument	6
The Petition Presents No Question Which Needs to Be Resolved by This Court	7
Petitioner Ignores the Further Ground for Invalidity in Failure to Satisfy 35 U. S. C. § 112	9
Conclusion	10

List of Authorities Cited.

Baltimore & Carolina Line, Inc. v. Redman, 295 U. S. 654 (1935) 6, 9
Berkeley Pump Co. v. Jacuzzi Bros., Inc., 214 F. 2d 785 (C. C. A. 9, 1954) 7
Brady v. Southern Railway Co., 320 U. S. 476 (1943) .. 6
Connors, et al. v. Ormsby, 148 F. 13 (C. C. A. 1, 1906) 7
Galloway v. United States, 319 U. S. 372 (1943) 6
Great A & P Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147 (1950) 6, 9
Himes, et al. v. Chadwick, 199 F. 2d 100 (C. C. A. 9, 1952) 7
Hotchkiss v. Greenwood, 11 How. 248, 267 7
McIlvaine Patent Corp. v. Walgreen Co., 138 F. 2d 177 (C. C. A. 7, 1943) 7
Northern Railway Company v. Page, et al., 274 U. S. 65 (1927) 6
Packwood v. Briggs and Stratton Corp., 195 F. 2d 971, 973 (C. C. A. 3—1952) 6, 7
Ryan Distributing Corp. v. Caley, 147 F. 2d 138 (C. C. A. 3—1945) 6, 7
Slocum v. New York Life Insurance Company, 228 U. S. 364 9
Wilkerson v. McCarthy, 336 U. S. 53 7

Statute.

35 U. S. C. § 112 9

IN THE

Supreme Court of the United States

OCTOBER TERM, 1957.

No. 407.

RALPH F. STALLMAN,

Petitioner,

vs.

CASEY BEARING COMPANY, INC.,
A CORPORATION,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

ADDITIONAL STATEMENT OF MATTER INVOLVED.

The present suit brought for damages only for alleged infringement of Stallman patent No. 2,334,227, was tried before a jury upon the demand of petitioner. At the conclusion of all evidence, respondent moved (R. 263) the District Court to direct the jury to return a verdict that the patent was invalid and not infringed. The Court denied the motion, and the jury returned a verdict that claims 3, 4, 5 and 9 of the Stallman patent were valid and infringed. Thereafter, on May 3, 1956, respondent filed a motion (R. 15) for judgment notwithstanding the verdict, or in the alternative, for a new trial, this matter was briefed and argued by both parties, and on July

31 the District Court granted such motion, and its opinion (R. 27) is reported at 144 Fed. Supp. 927. On May 31, 1957, the Court of Appeals affirmed the decision of the District Court, as petitioner has stated, and its opinion is reported at 244 F. 2d 905 (also Appendix of Petition).

Respondent is a distributor and manufacturers' representative for some fifteen manufacturers (R. 116) of bearings, roller chains and sprockets, oil seals, oil rings, and retaining rings, including McGill Manufacturing Company, Inc., of Valparaiso, Indiana, as one of the manufacturers. Petitioner originally charged respondent, and its president, Thomas W. Crosby, as well as McGill, with infringement of the Stallman patent. The action was dismissed on motion as to McGill Manufacturing Company, Inc., by order of the District Court on August 9, 1954, and was then dismissed on motion at the conclusion of the trial as to Crosby by order of April 20, 1956.

Petitioner's statement of the case is substantially a duplicate of that which he made before the Court of Appeals. There, and here, the alleged invention of the patent is described in a manner which superficially disguises its correspondence with the prior art, and such prior art is similarly misrepresented in its anticipatory showing.

The Stallman patent (R. 286) has no description corresponding to that on pages 5 and 6 of the present petition.

The four claims in suit (3, 4, 5 and 9) in varying scope describe a roller bearing or anti-friction bearing structure comprising rollers which are slotted or recessed intermediate their ends and maintained within a space having an innerrace as the inside surface engaging the rollers and an outer race as the outside surface for such space. One of the races normally rotates and the other is stationary during operation of the bearing when it is installed in a machine or other equipment. A guide rib or track or rail,

as it is sometimes called, is provided on one of the races and it extends into the slots or recesses in the rollers. The guide rib prevents the rollers from moving endwise out of the bearing and limits the degree of misalignment of the rollers relative to the longitudinal axis of the rollers within the bearing. This is admittedly old in the prior art.

Petitioner contended at the trial that he was the first to perceive that superior results over prior bearings were possible if the guide rib was always on the stationary race in the bearing, and if the bearing was so mounted in apparatus, then misalignment of the rollers was eliminated and undesirable friction in the bearing was avoided.

The structural combination of the claims in suit is clearly shown in the prior U. S. patents 585,580 to Kempster (1897) (R. 296); Kempster 747,324 (1903) (R. 308); Heim 1,885,914 (1932) (R. 302); and the British patent 17,841 (1906) (R. 292). The structural combination of the Stallman patent and the alleged functional discovery that the guide rib or track should be on the stationary race of the bearing are shown in Figs. 4 and 5 of Kempster patent 747,324, and in Fig. 6 of the British patent.

The District Court in instructing the jury, without objection from petitioner in any respect, summed up the evidence (R. 272):

> "The plaintiff in this case does not claim that the roller is something new; that the slot in the roller is something new; that the track upon which this proceeds in the rolling operation is something new, or that it operates between an outer and an inner surface which the lawyers have called races—none of those things he claims is new.
>
> "As I understand the contentions of the parties in this case, the principal contention of the plaintiff as to the originality of the claims of the patent is that this track on which the roller operates is fixed—the track is fixed to it and it remains immovable,

whereas the other container, the inner container, may be movable. The chief claim that he makes is the rigidity or firmness of this outside container in which the roller bearing rolls over a fixed sort of a track."

The law governing the validity of the patent was given to the jury (R. 272, 273):

"• • • that if that which has been developed or claimed to have been invented goes beyond what the ordinary artisan skilled in that particular field of mechanics could do, then it amounts to invention, and if it is not something more than the ordinary artisan or skilled—person skilled in that particular work would produce as a result of his general knowledge—if it is not something more than that, then it is not invention."

RESTATEMENT OF QUESTION PRESENTED FOR REVIEW.

Restating petitioner's present position as it is understood from the petition; he raises the question whether Rule 50(b) of the Federal Rules of Civil Procedure is constitutional, and whether the District Court had the right to apply to the simple mechanical structure involved in the patent in suit a minimum standard of invention, and applying that standard as a matter of law, set aside the verdict.

Petitioner presents the question by his petition as though the matter of the validity of the patent in suit, or invention over the prior art, is a fact issue wherein the verdict of the jury is inviolate, and he contends that the District Court and the Court of Appeals respectively violated his right of trial by jury by setting aside the verdict. Or, describing the petitioner's position more simply; he assumes that invention is a question of fact, but ignores the standards by which the facts are to be measured.

Actually, the petition presents the same proposition of possibly every plaintiff-patentee whose patent has been held invalid, namely, whether this Court should review the action of the Court below in holding as a matter of law that no patentable invention is represented in the patent in suit.

ARGUMENT.

In every case where the validity of a patent is in issue, whether it be a jury or a non-jury case, the standard of invention controls that issue, and it is that question which must be decided as an issue of law. This Court has so held, and there is no diversity from that principle in the Courts of Appeals of the ten Federal Circuits. *Great A & P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950). Furthermore, "a jury in a patent case is not free to treat invention as a concept broad enough to include whatever discovery or novelty may impress the jurors favorably." *Packwood* v. *Briggs and Stratton Corp.*, 195 F. 2d 971, 973 (C. C. A. 3—1952). (Certiorari denied, 344 U. S. 844, and rehearing denied 344 U. S. 882.)

This Court has long held that the guaranty of a jury trial in an action at law given by the Seventh Amendment to the Federal Constitution does not deprive the Federal Courts of the power in a jury case to set aside the verdict of the jury and grant a motion for judgment n. o. v. as a matter of law, and has thus determined the constitionality of Rule 50(b) (F. R. C. P.). *Baltimore & Carolina Line, Inc.* v. *Redman*, 295 U. S. 654 (1935); *Northern Railway Company* v. *Page, et al.*, 274 U. S. 65 (1927); *Galloway* v. *United States*, 319 U. S. 372 (1943); *Brady* v. *Southern Railway Co.*, 320 U. S. 476 (1943); *Ryan Distributing Corp.* v. *Caley*, 147 F. 2d 138 (C. C. A. 3—1945).

The Petition Presents No Question Which Needs To Be Resolved by This Court.

(1) There are no conflicts in decisions in this case for the District Court set aside the verdict on respondent's motion for judgment n. o. v., and the Court of Appeals affirmed such decision. This is the only adjudication of the Stallman patent.

(2) There is no novel question of jury law or procedure, for it is not uncommon for jury verdicts in patent cases to be set aside on the grounds that the jury did not apply the requisite standard of patentability to sustain the patent.

Packwood v. *Briggs & Stratton, supra.*

Himes, et al. v. *Chadwick,* 199 F. 2d 100 (C. C. A. 9, 1952).

Berkeley Pump Co. v. *Jacuzzi Bros., Inc.,* 214 F. 2d 785 (C. C. A. 9, 1954).

Ryan Distributing Corp. v. *Caley,* 147 F. 2d 138 (C. C. A. 3, 1945).

McIlvaine Patent Corp. v. *Walgreen Co.,* 138 F. 2d 177 (C. C. A. 7, 1943).

Connors, et al. v. *Ormsby,* 148 F. 13 (C. C. A. 1, 1906).

Reference is made to *Hotchkiss* v. *Greenwood,* 11 How. 248, 267. The decision of this Court in that case revolved around the question of the proper instruction to the jury in a patent case. Inasmuch as this Court affirmed the Circuit Court for the District of Ohio and concluded that the patent was invalid for want of invention, there is no discernible conflict with the action of the District Court in the present case, nor with the concurring decision of invalidity from the Court of Appeals.

Petitioner refers to this Court's decision in *Wilkerson*

v. *McCarthy*, 336 U. S. 53, but it does not in any way affect the controlling law in the decisions of this Court above cited. This was a case under the Federal Employer's Liability Act, and as this Court said (page 55):

> "It was because of the importance of preserving for litigants in FELA cases their right to a jury trial that we granted certiorari in this case."

Furthermore, the District Court in the present case was particularly solicitous of petitioner's rights, and of the verdict of the jury as evidenced in the Court's opinion (R. 27, 28):

> "Upon the conclusion of the evidence, defendant moved for a directed verdict in its favor on the ground that the claims in suit were invalid as a matter of law. Believing that the question tendered by the motion warranted a careful study which could more conveniently be made, if necessary, upon a motion for judgment notwithstanding the verdict, the Court denied the motion for a directed verdict and submitted the cause to the jury. The jury returned a verdict that the four claims in suit were valid and infringed. Defendant thereupon moved for judgment notwithstanding the verdict. An appraisal of the entire record in the light of the oral and written arguments upon the motion, compels the conclusion that the claims in suit are invalid as a matter of law and that the verdict must be set aside and judgment entered for defendant."

The Court of Appeals in its entire opinion shows clearly that it had carefully considered the entire record in this case, and concluded its decision:

> "We agree with the District Court in its conclusion, both as to the law applicable to the evidence, and the legal conclusion it came to thereon. The only reasonable conclusion is that the patent is invalid by reason of the prior art. *General Electric Co.* v. *Jewel Incandescent Lamp Co.*, 326 U. S. 242, 249, 66 S. Ct.

81, 90 L. Ed. 43; *Gratiot* v. *Farr Company*, 9 Cir., 237 F. 2d 940."

Petitioner also refers to *Slocum* v. *New York Life Insurance Company*, 228 U. S. 364. However, this decision is controlled by *Baltimore and Carolina Line* v. *Redman*, *supra*, in which the *Slocum* decision is specifically referred to.

(3) The instant case, so far as a question of the validity of a patent is concerned, follows the settled principle that a patent, as a matter of law, must meet a minimum standard of invention to be upheld. *Great A & P Tea Co.* v. *Supermarket Equipment Corp.*, *supra*.

Petitioner Ignores the Further Ground for Invalidity in Failure to Satisfy 35 U. S. C. § 112.

Quite apart from the issue of the function of the jury on the question of invention over the prior art, the Stallman patent fails to describe and claim the alleged invention with the definiteness and particularity specified by the Statutes, and it is invalid as not meeting the requirements of 35 U. S. C. § 112, which reads;

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
>
> An element in a claim for a combination may be expressed as a means or step for performing a speci-

fied function without the recital of structure, material, or acts in support thereof, and such claims shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

The District Court discussed this (R. 31—footnote) although it did not pass on the issue, and the Court of Appeals referred to it (Petition Appendix, page v) in their decision.

Therefore, if we assume for purposes of argument that there might be a question on the jury issue, the patent is invalid as a matter of law for indefiniteness, and the ultimate conclusion of the case would be the same.

CONCLUSION.

The decision of the Court of Appeals for the Ninth Circuit is in complete harmony with the decision of this Court and of all of the other Federal Courts, as well as with the principles of common law relating to trial by jury.

There remains in this case no question to be resolved by this Court.

The Petition for Writ of Certiorari should, therefore, be denied.

Respectfully submitted,

FOORMAN L. MUELLER,
105 West Adams Street,
Chicago 3, Illinois,

JAMES M. NAYLOR,
420 Russ Building,
San Francisco 4, California,
Attorneys for Respondents.

September 23, 1957.